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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,143	03/06/2007	Jordi Tormo i Blasco	5000-0173PUS1	6443

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EXAMINER	
HOLT, ANDRIAE M	

ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
02/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/579,143	TORMO I BLASCO ET AL.	
	Examiner	Art Unit	
	Andriae M. Holt	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/15/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The examiner acknowledges the receipt of the preliminary amendment filed on May 15, 2006.

Claims 1-14 are pending in the application. Claims 1-14 will be examined on the merits.

Applicant is advised to replace the "comma" in 0,1 kg/ha with a period in claim 6 and insert "A" in front of seed in claim 9.

Priority

Priority to PCT/EP04/13071 filed on November 18, 2004, which claims priority to German Application No. 10355980.9 filed on November 27, 2003 is acknowledged.

Information Disclosure Statement

Receipt of Information Disclosure Statement filed on May 15, 2006 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 provides for the use of compounds I and II for preparing a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

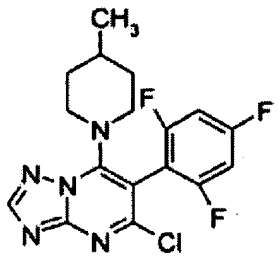
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees et al. (US 6,552,026).

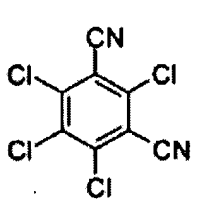
Applicant's Invention

Applicant claims a fungicidal mixture comprising 1) a triazolopyrimidine derivative of formula I



and

2) chlorothalonil of the formula II

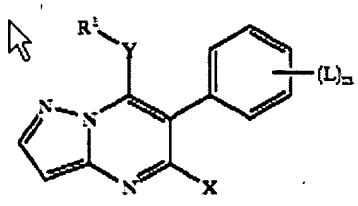


in a synergistically effective amount. Applicant also claims a method of controlling rice—pathogenic harmful fungi, particularly *Corticium sasakii*.

Determination of the scope of the content of the prior art

(MPEP 2141.01)

Pees et al. teach compounds of formula I



that are used to control phytopathogenic fungi (col. 1, lines 10-20).

Pees et al. further teach that particular preference is given to [5-chloro-6-(2,4,6-trifluoro-phenyl)-7-(4-methyl-piperidin-1-yl)1,2,4]triazolo[1,5-a]pyrimidine (col. 9, lines 30-33)(claim 1, compound of formula I, instant invention). Pees et al. teach the fungicidal compositions can be applied to the plants or their environment simultaneous with or in succession with other active substances, including chlorothalonil (col. 15, line 46) (claims 1, and 4-5, chlorothalonil, treating in environment and application, instant invention). Pees et al. teach the compositions preferably contain from 0.5 % to 95% of weight of active ingredient composition (col. 12, lines 39-41) (claim 2, weight, instant invention). Pees et al. further teach a carrier in the composition may be solid or a liquid (col. 12, lines 46-47) (claims 3 and 10-11, carrier, instant invention). Pees et al. teach the invention is of wide applicability in the protection of crop and ornamental plants against fungal attack. Pees et al. further teach typical crops which may be protected include rice (col. 16, lines 42-50) (claim 4, control of rice –pathogenic harmful fungi, instant invention). Pees et al. teach when the composition is used in crop protection, the rates of application are from 0.01 to 2.0 kg of active ingredient per ha, depending on the nature of the effect desired (col. 11, lines 65-67) (claims 6 and 13, application amount, instant invention). Pees et al. further teach the treatment of seed, amounts of active ingredient of from 0.0001 to 0.1 g, preferably 0.01 to 0.05 g, are generally required per kilogram of seed (claims 8-9 and 14, instant invention). Pees et al. teach the compositions can be used in fields for the control of phytopathogenic fungi such as *Rhizoctonia solani* which is synonymous with *Corticium sasakii* of the instant invention

as noted in the specification of the instant application on page 2, line 29 (col. 12, lines 11-23) (claims 7 and 12-13, *Corticium sasakii*, instant invention).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Pees et al. do not teach the explicit combination of compounds of formula I and formula II.

Finding a prima facie obviousness
Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the triazolopyrimidine derivative of formula I with chlorothalonil to produce a fungicidal mixture to control rice pathogens because Pees et al. teach that such a combination can be made. One would have been motivated to make this combination in order to receive the expected benefit of a fungicidal composition that provides a broad spectrum of activity against the phytopathogenic fungi that attacks rice crops. Given the state of the art as evidenced by the teaching of Pees et al., and absent any evidence to the contrary, there would have been a reasonable expectation of success in combining the compounds to produce a fungicidal mixture that would provide broader coverage and control, reduced application rates and yield higher rice crops.

The examiner notes that Applicant claims a synergistic fungicidal mixture. Examiner notes table B of the specification, discloses results of mixtures of active

compounds, concentrations, and mixing ratios of compounds I and II. Examples 6, 7, and 8 show the mixing ratios of 4:1, 1:1 and 1:4, respectively with unexpected results, which is a narrower range than the purported weight ratio range of 100:1 to 1:100 in claim 2 of the instant application. The examiner cannot conclusively determine if the broader weight ranges would have the same unexpected results as the examples provided in table B. Therefore, the examiner notes that the claims are not commensurate in scope with the comparative data.

None of the claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andriae M. Holt whose telephone number is 571-272-9328. The examiner can normally be reached on 7:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richter Johann can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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